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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/234,253	01/20/1999	RAYMOND SELTZER	A-21835/P2/C	6356

324 7590 02/26/2003

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PATENT DEPARTMENT
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EXAMINER

ALVO, MARC S

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 02/26/2003

26

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/234,253

571
Applicant(s)

SELTZER ET AL.

Examiner

Steve Alvo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40, 44 and 45 is/are pending in the application.
- 4a) Of the above claim(s) 12-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 35-40, 44 and 45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

The final rejection of 11-18-2002 is withdrawn and the following rejection given:

Applicant in the brief states that claims in Serial No. 09/481,665 contains similar claims.

Accordingly the following new rejections are made:

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-11, 35-40 and 44 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over all the of copending Application No. 09/481,665. Although the conflicting claims are not identical, they are not

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patentably distinct from each other because the claims of this application read on the stabilizing agents claimed by 09/481,655.

Claims 1-11, 35-40 and 44 are rejected under the judicially created doctrine of double patenting over all the claims of U. S. Patent Nos. 6,254,724 or 6,500,303 or 6,447,644, since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: The claims of U. S. Patent Nos. 6,254,724 or 6,500,303 or 6,447,644 read on the stabilizing agents claimed in the instant Application. For example, claim 7 of '724 includes the same "X" components, e.g. citrate, claimed in the instant Application. The claims of '724 include the UVA's of column 39. These are the same UVA's included in the instant claims.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claims 1-11, 35-40 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over SELTZER et al in view of RODGERS et al.

Claims 1-11, 35-40 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over SELTZER et al '511 in view of RODGERS et al.

SELTZER et al teaches adding mixtures of UV absorbers and light stabilizing agents, including N,N-diethylhydroxylamine (column 11, line 35 and column 12, line 66), to polymer

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coating compositions including polyurethane (column 8, line 12) and polyesters (column 8, line 30). RODGERS et al teaches polyurethane and polyester coating compositions containing UV absorbers, including benzotriazoles (column 5, line 28 and Example 1), can be used to coat paper and textiles to prevent fading of dyes (column 1, lines 35-40 and abstract). It would have been obvious to the routineer that the polyesters and polyurethanes of SELTZER et al which contain UV absorbers can be used to coat paper and textiles to prevent fading of dyes, e.g. reducing the loss of brightness, in the manner taught by RODGERS et al. SELTZER et al teaches that benzotriazoles are of particular value as the UV absorber. RODGERS et al teaches that 3-(2H-benzotriazol-2-yl)-4-hydroxy-5-sec-butylbenzene sulfonic acid or its sodium salt (CIBAFST®W) can be used as the benzotriazol UV absorber (Example 21, see Table, column 13). It would have been prima facie obvious to use the 3-(2H-benzotriazol-2-yl)-4-hydroxy-5-sec-butylbenzene sulfonic acid or its sodium salt (CIBAFST®W) as the benzotriazol of SELTZER et al as they perform the same function of UV absorption. The claimed N,N-diethylhydroxylammonium citrate would be a salt of and an obvious variant of the genus N,N-hydroxylamine. It would have been obvious to combine the teachings of SELTZER with that of RODGERS to obtain the benefits of both preventing fading and increasing brightness. Besides, the claims drawn to a composition and not to the use of the composition. As set forth above, It would have been obvious to the routineer that the polyesters and polyurethanes of SELTZER et al which contain UV absorbers can be used to coat paper and textiles to prevent fading of dyes in the manner taught by RODGERS et al.

The arguments, including the Declaration of Mr. David Vidal, have been considered but are not convincing as RODGERS et al teaches that the composition can be used to coat paper.

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RODGERS et al teaches, column 8, lines 35-38, "for paper, addition to wet pulp, but here also, surface application by a spraying or a coating process is preferable. It is possible to mix the inventive UV-absorbing polymers with other finishing agents for paper". Besides the claims are drawn to a composition. The use of the composition, e.g. to brighten paper, cannot be given probative weight in a product claim. SELTZER teaches using both light absorbers and light stabilizing agents. It would have been obvious to use the UV absorber of RODGERS for the UV absorber of SELTZER. RODGERS et al teaches that 3-(2H-benzotriazol-2-yl)-4-hydroxy-5-sec-butylbenzene sulfonic acid or its sodium salt (CIBAFST®W) can be used as the benzotriazol UV absorber (Example 21, see Table, column 13). It would have been prima facie obvious to use the 3-(2H-benzotriazol-2-yl)-4-hydroxy-5-sec-butylbenzene sulfonic acid or its sodium salt (CIBAFST®W) as the benzotriazol of SELTZER et al as they perform the same function of UV absorption. It would have been prima facie obvious to substitute one known UV-absorber for another.

Claim 45 has not been rejected over the art as it would not have been obvious to use the specific 3-(2H-benzotriazol-2-yl)-4-hydroxy-5-sec-butylbenzene sulfonic acid or its sodium salt with the citrate salt of tris(N,N-diethylhydroxylammonium) of SELTZER.

Claim 45 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and if proper terminal disclaimers are filed.

This election of species requirement was made Final in Paper No. 9. Applicant elected within the method claims (1-43) the following species: N,N-diethylhydroxylamine or its salt (see Office Action mailed 8-1-2000) as the hydroxylamine and 3-(2H-benzotriazol-2-yl)-4-

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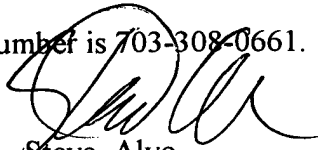
hydroxy-5-sec-butylbenzene sulfonic acid or its sodium salt (CIBAFST®W) as the stabilizer.

Withdrawn claims 12-34 contain non-elected species.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Alvo whose telephone number is 703-308-2048. The examiner can normally be reached on 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on 703-308-3837. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Steve Alvo
Primary Examiner
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msa

February 24, 2003